

REMARKS

This amendment is filed together with a Request for Continued Examination and responds to the Office Action mailed October 22, 2004. A Petition for Extension of Time to respond to the Patent Office Action is submitted herewith, together with the required fee.

Allowance of claims 6 and 8-9 is noted. Claim 7 has been amended to depend, as previously intended, from allowed claim 6, and claim 10 has similarly been amended to depend from allowed claim 9. Claims 7 and 10 should thus now be in form for allowance, which is requested.

The Examiner rejected claims 1-5 under 35 U.S.C. §112, first paragraph, as lacking enabling support in the specification. The Examiner continues, as in the Office Action of April 9, 2004, to contend that each of claims 1-5 claims a multipurpose tool having a single handle, and that the specification supports only a multipurpose tool having a pair of handles and jaws.

Applicant continues to disagree with the Examiner's position that the invention defined by original claims 1-5 was not enabled by the disclosure.

Claims 1 and 2 are identical with original claims 33 and 35 of U.S. Patent Application Serial No. 09/240,204, which is the grandparent of this application. Similarly, claims 4 and 5 are identical with claims 41 and 42 of U.S. Patent Application Serial No. 09/240,204, as originally filed. Such original claims form a part of the disclosure of that original application. Claim 3 of this application is not identical with but is clearly based on original claim 34 of U.S. Patent Application Serial No. 09/240,204. Claim 3 places original claim 34 of the grandparent application Serial No. 09/240,204 into independent form, revising the language of claim 34 of the grandparent application to recite more specifically "a tool bit having a shank located in said tool bit drive socket" instead of "a tool bit received in said socket". While the wording of claim 3 is not identical with claim 34 of the grandparent application, it is clear that it is directed to the same invention, and claim 3 is therefore supported by original claim 34 of the grandparent application, in accordance with 35 U.S.C. §112, first paragraph.

It is longstanding law that original claims constitute their own description, and that later added claims of similar scope and wording are described thereby. As stated in the Manual of Patent Examining Procedure, §2163A.,

There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) ("we are of the opinion that the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims").

While MPEP §2163A. goes on to recognize that there are cases where one skilled in the art would not recognize that the applicant had possession of the claimed invention, the present case is not such a case. The claims of this application do not require any essential or critical feature which is not adequately described in the specification and which is not conventional in the art or known to one of ordinary skill in the art. It is well-known, for example, that features of multipurpose tools having two handles may also be useful in tools having a single handle, and that subassemblies of multipurpose hand tools may have separate utility apart from a particular version of such a multipurpose tool. Various combinations of tool blades, handles, and jaws may be desirable for different potential users of such tools. For example, a fisherman may desire to have different blades and jaws available than those desired by an electrician, or by a motor mechanic.

The Examiner states that "the invention as disclosed requires two handles and jaws," and states that there is no support for a tool having only one handle. An invention is defined by the claims, however, and original claims form part of the disclosure. Accordingly, the inventions of claims 1-5 were disclosed in the original claims themselves, as well as in the other parts of the specification, and thus are supported as claimed originally.

Furthermore, the inventions defined by claims 1-5 are clearly mentioned as a separate aspect of the invention, in the Summary of the Invention, on page 4, lines 29-34, of the specification, and the structural details of the inventions of claims 1-5 are described on page 20, line 13, through page 21, line 9, and are shown in FIGS. 19 and 20.

Applicant does not agree that claims 1-5 require that a multipurpose tool have only one handle as contended by the Examiner. Independent claims 1, 3, and 4 use the transitional word "comprising" which denotes an "open" claim, i.e., the elements and limitations recited in the claim are not exclusive. See MPEP at §2111.03. Thus the recitation of the element of "a handle" in these independent claims limits neither independent claims 1, 3, and 4 nor their dependent claims 2 and 5 to a single handle, as the Examiner suggests. Instead, recitation of "a

handle" in each of claims 1, 3, and 4, 11, 13, and 14 can and should be understood as meaning "at least one."

The Examiner has also rejected claims 11-15. Each of these claims is directed to a respective subassembly of a multipurpose tool, each such subassembly including a handle that corresponds to a handle as recited in original claims 1-5. The subject matter of each of claims 11-15 is fully disclosed by the same portions of the specification and drawings of this divisional application as mentioned above with respect to claims 1-5, as well as by the original claims 33-35 and 41-42 of the grandparent application Serial No. 09/240,204.

Thus the subassemblies defined by claims 11-15 are well disclosed, in a way that clearly informs that the inventor was in possession of the claimed inventions. It is amply clear from the detailed description at page 20, line 13 through page 21, line 9, and from FIGS. 19 and 20 of the drawings how to construct such claimed subassemblies, and it is clear from the Summary of the Invention at page 4, lines 29-34, that the tool bit drive socket is considered to be a separate aspect of the disclosed multipurpose tool. Claims 11-15 thus are sufficiently enabled by the disclosure of the application as filed and should therefore be allowable.

In view of the foregoing, the Examiner is requested to reexamine the application, to allow all of claims 1-15, and to pass the application on promptly to issue.

Respectfully submitted,



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